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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,108	07/28/2003	Kazuo Koyama	03338CIP/HG	6344

1933 7590 03/21/2007  
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
220 Fifth Avenue  
16TH Floor  
NEW YORK, NY 10001-7708

EXAMINER
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SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/629,108

**Applicant(s)**

KOYAMA ET AL.

**Examiner**

Taofiq A. Solola

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 46-62, 66-68, 70-74, 76, 78-92, 102-109, 111-117 and 119-133 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 46-62, 66-68, 70-74, 76, 78-92, 102-109, 111-117 and 119-133 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: _____  |

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Claims 46-62, 66-68, 70-74, 76, 78-92, 102-109, 111-117, 119-133 are pending in this application.

Claims 1-45, 63-65, 69, 75, 77, 93-101, 110, 118 are canceled.

### ***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.117(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/29/06 has been entered.

### ***Priority Claim***

The instant application is a CIP of PCT/JP02/00400, which published as WO 2002/059074 on 8/1/02. In the WO '074 publication, Ra and R1 are alkyl; R2 and R3 are H; A is alkylene; E is O; X1 and X2 are O and S; Arom is aryl. Therefore, the priority claim is granted for the above listed substituents only, while it is denied for all other claimed substituents.

The priority claim based on the Japanese applications 18386, filed 1/26/01 and 305182, filed 10/1/01 is denied on the above listed substituents because certified copies of the documents are not yet received. However, the denial would be revisited when the copies are filed.

### ***Withdrawal of Allowability***

The indicated allowability of claims 46-62, 66-68, 70-74, 76, 78-92, 102-109, 111-117, 119-133 is withdrawn in view of the newly discovered reference(s) to Krogen et al., Org. Letts. (2002), Vol. 4(20), pages 3359-3362. Rejections based on the newly cited reference(s) follow.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 46-62, 66-68, 70-74, 76, 78-84, 102-109, 111-117, 119-133 are rejected under 35 U.S.C. 102(a) as being anticipated by Krogen et al., Org. Letts. (2002), Vol. 4(20), pages 3359-3362. Published on the Web 9/5/02.

Krogen et al., disclose compound salt (S)-4 and its method of use for treating Alzheimer, depression, irritability and anxiety. See line 1, column 1 and lines 1-2, column 2, page 3359.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 185-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krogen et al., Org. Letts. (2002), Vol. 4(20), pages 3359-3362.

Applicant claims the compositions of compounds of formula (I).

**Determination of the scope and content of the prior art (MPEP 2141.01)**

Krogen et al., teach compound (salt) S-4 and its method of use for treating Alzheimer disease, depression, irritability and anxiety. See line 1, column 1 and lines 1-2, column 2, page 3359.

**Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)**

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The difference between the instant invention and that of Krogen et al., is that applicant claims the composition while Krogen et al., teach the compound methods of using it.

*Finding of prima facie obviousness--rational and motivation (MPEP 2142.2413)*

However, to use the compound of Krogen et al., it must necessarily be in the form of a composition. Therefore, the instant invention is prima facie obvious from the teaching of Krogen et al. One of ordinary skill in the art would have known to claim the composition at the time this invention was made. The motivation is from knowing that the compound is useful for treating Alzheimer disease, depression, irritability and anxiety.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas McKenzie, can be reached on (571) 272-0670. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1625

March 17, 2007